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OLSON & HIERL, LTD. 20 NORTH WACKER DRIVE 36TH FLOOR CHICAGO, IL 60606			ART UNIT 1652	

DATE MAILED: 04/07/2006

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/538,248  
Filing Date: March 29, 2000  
Appellant(s): CHERESH ET AL.

Talivaldis Cepuritis  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/13/06 appealing  
from the Office action mailed 8/23/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

Appellants statement identifying the appeal of related application 10/298,377 is contained in the brief.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

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2003/0187001 Calderwood et al. 10-2003

2002/0156081 Hirst et al. 10-2002

Hanke J.H. et al. "Discovery of a novel, potent and Src family-selective tyrosine kinase inhibitor" J. Biol. Chem. 271(2):695-701. (Jan. 1996).

A.F. Burchat et al. "Pyrrazolo[3,4-d]pyrimidines containing an extended 3-substituent as potent inhibitors of Lck - a selectivity insight" Bioorganic & medicinal chemistry letters 12:1687-1690. (2002).

A.F. Burchat et al. "Pyrrolo[2,3-d]pyrimidines Containing an Extended 5-Substituent as Potent and Selective Inhibitors of lck II" Bioorganic & medicinal chemistry letters 10:2171-2174. (2000).

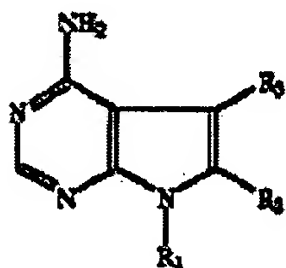
In re Ngai, 70 USPQ2d 1862 (CAFC 2004).

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 17, and 18 stand rejected under 35 U.S.C. 102(e) as being anticipated by Calderwood et al. (US Patent 6,001,839) as evidenced by Burchat et al. (2000).

Calderwood et al. teach methods of treating diseases including VEGF mediated edema using tyrosine kinase inhibitors having the structure shown below (see column 13, lines 29-48).



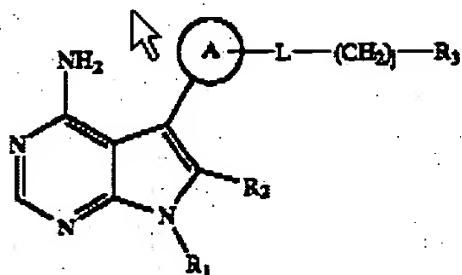
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These compounds are disclosed as inhibitors of tyrosine kinases including Src kinases (see column 12 line 53 - column 13, line 10). Calderwood et al. further teach pharmaceutical compositions of the disclosed compounds. The disclosure of Calderwood et al. includes the disclosure of pharmaceutical compositions including and the use of the specific compounds 7-isopropyl-5-(4-phenoxyphenyl)-7H-pyrrolo[2,3-d]pyrimidin-4-ylamine, (column 9, lines 7-8), 5-[4-(4-aminophenoxy)phenyl]-7-tert-butyl-7H-pyrrolo[2,3-d]pyrimidin-4-ylamine (column 9, lines 32-33), and 5-[4-(3-aminophenoxy)phenyl]-7-tert-butyl-7H-pyrrolo[2,3-d]pyrimidin-4-ylamine (column 9, lines 34-35), which Burchat et al. (2000) evidence are src kinase inhibitors (see Table 2). Thus Calderwood et al. anticipate all of the instant claims.

Claims 1, 2, 17, and 18 stand rejected under 35 U.S.C. 102(e) as being anticipated by Calderwood et al. (US Patent Application 2003/0187001) as evidenced by Burchat et al. (2000).

Calderwood et al. teach methods of treating diseases including VEGF mediated edema using tyrosine kinase inhibitors having the structure shown below (see paragraph 56 and 101).

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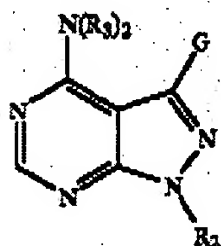


These compounds are disclosed as inhibitors of tyrosine kinases including Src kinases (see paragraphs 53 and 111). Calderwood et al. further teach pharmaceutical compositions of the disclosed compounds. The disclosure of Calderwood et al. includes the disclosure of pharmaceutical compositions including and the use of the specific compounds 4-[4-(4-amino-7-isopropyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)phenoxy]benzyl Alcohol, (paragraph 0482), 2-[4-(4-amino-7-isopropyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)phenoxy]benzyl Alcohol (paragraph 0495), 4-[4-(4-amino-7-isopropyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)phenoxy]benzonitrile (paragraph 0439) and 2-[4-(4-amino-7-isopropyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)phenoxy]benzonitrile (paragraph 0447), which Burchat et al. (2000) evidence are src kinase inhibitors (see Table 2). Thus Calderwood et al. anticipate all of the instant claims.

Claims 1, 2, 17, and 18 stand rejected under 35 U.S.C. 102(e) as being anticipated by Hirst et al. (US Patent Application 2002/0156081) as evidenced by Burchat et al. (2002).

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Hirst et al. teach methods of treating diseases including edema using tyrosine kinase inhibitors having the structure shown below (see paragraph 315 and 350).



These compounds are disclosed as inhibitors of tyrosine kinases including Src kinases (see paragraphs 311 and 349). Hirst et al. further teach pharmaceutical compositions of the disclosed compounds. The disclosure of Hirst et al. includes the disclosure of pharmaceutical compositions including and the use of the specific compounds trans-Benzyl N-[4-[4-amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]carbamate (see paragraph 0686), trans-N-[4-[4-Amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]benzamide (see paragraph 0697), trans-N-[4-[4-Amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]-2,2-dimethyl-3-phenylpropanamide (see paragraph 2549), trans-N-[4-[4-Amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]-3-methyl-3-phenylbutanamide (see paragraph 2562), trans-N-[4-[4-Amino-1-[4-(4-

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methylnpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]benzo[b]furan-2-carboxamide, (see paragraph 2585), Trans-3-[4-(Benzylamino)-3-methoxyphenyl]-1-[4-(4-methylnpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-4-amine, (see paragraph 0929) and trans-N-[4-[4-Amino-1-[4-(4-methylnpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]-3-phenylpropanamide (see paragraph 1696) which Burchat et al. (2002) evidence are src kinase inhibitors (see Tables 3 and 4). Thus Hirst et al. anticipate all of the instant claims. While the effective filing date of Hirst et al. (9/17/99) falls after some of the claimed priority dates of the instant application, none of the claimed prior applications teach the use of small organic chemical inhibitors of Src family tyrosine kinases for treatment of conditions related to vascular leakage or edema and neither PCT/US99/11780 nor provisional application 60/087,220 provide support for treatment of conditions related to vascular leakage or edema as is currently claimed. As such the instant claims have not been granted the benefit of the filing date of the prior applications.

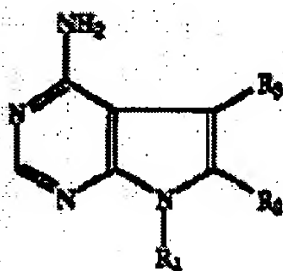
Claims 3, 4, 19, 20, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calderwood et al (US Patent 6,001,839), Calderwood et al. (US Patent Application



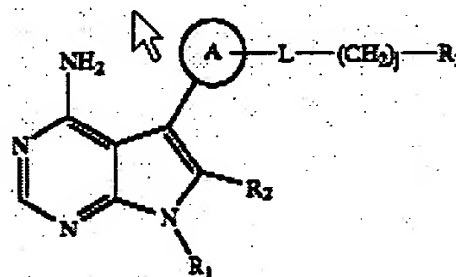
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2003/0187001) and Hirst et al. (US Patent Application 2002/0156081) in view of Hanke et al.

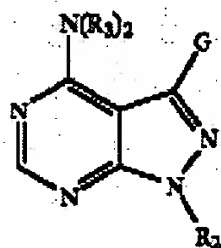
Calderwood et al (US Patent 6,001,839), Calderwood et al. (US Patent Application 2003/0187001) and Hirst et al. are all discussed above. Each of the above teach the treatment of edema with tyrosine kinase inhibitors having the general structures shown below which inhibit tyrosine kinases including Src kinases. None of them specifically teach the use of the pyrazolopyrimidines PP1 or PP2 for the treatment of edema.



Calderwood et al. Patent



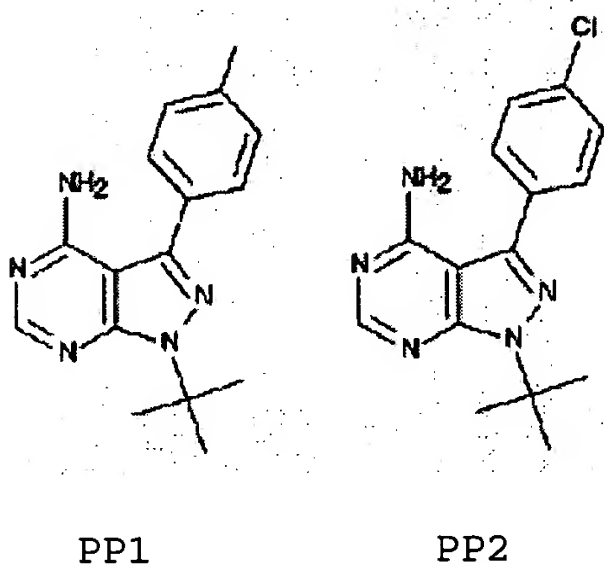
Calderwood et al. Application



Hirst et al.

Hanke et al. teach the pyrazolopyrimidines PP1 and PP2 having the structures shown below.

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Hanke teach that PP1 and PP2 are tyrosine kinase inhibitors which inhibit Src kinases. Hanke et al. do not teach the use of PP1 or PP2 to treat edema.

The structural similarity of PP1 and PP2 to the tyrosine kinase inhibitors of Calderwood et al (US Patent 6,001,839), Calderwood et al. (US Patent Application 2003/0187001) and Hirst et al. is readily apparent to a skilled artisan and these compounds are similarly disclosed as tyrosine kinase inhibitors which inhibit tyrosine kinases including Src kinases. As such it would have been obvious to one of skill in the art to use PP1 and PP2 to treat edema as taught by Calderwood et al (US Patent 6,001,839), Calderwood et al. (US Patent Application 2003/0187001) and Hirst et al. for the structurally and functionally similar tyrosine kinase inhibitors. Furthermore, it should be noted that even if one were to conclude that there is not a reasonable expectation of treating edema with PP1 and

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PP2, the instant references would still make obvious claims 19, 20, and 32, as the combination clearly makes obvious a pharmaceutical composition of the Src kinase inhibitors of Hanke et al. for the treatment of cancer or osteoporosis as Hirst et al. clearly teach that Src kinase inhibitors are known to be useful for treatment of these conditions (see paragraph 0037). The inclusion of a pharmaceutical composition in a package with printed material is well known in the art and does not define a patentable feature of the composition. What the printed matter states cannot define the invention. While a new use for an old product may be patentable the product itself is not. The intended use (as defined by the words on the label of Claims 19, 20, and 32) of a composition does not limit the composition itself. (see *In re Ngai*, 70 USPQ2d 1862).

**(10) Response to Argument**

**A. Rejection of Claims 1, 2, 17 and 18 over Calderwood et al. (US Patent 6,001,839) as evidenced by Burchat et al. (2000).**

Appellants argue that the Calderwood et al. patent teaches that certain pyrrolopyrimidine compounds are useful for treating VEGF mediated edema but only generally mentions the Src family of tyrosine kinases along with other classes of kinases and the Calderwood et al. patent does not teach that the disclosed pyrrolopyrimidine compounds are inhibitors of human c-src. The

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selectivity of tyrosine kinase inhibitors is highly unpredictable with large variability in selectivity and activity depending on the spatial arrangement of substituents. This is not persuasive because Calderwood et al. clearly teach the use of all the specific compounds listed in columns 7-10 for the treatment of VEGF-mediated edema (see column 13, lines 29-48) and Burchat et al. clearly evidence that at least the specific compounds 7-isopropyl-5-(4-phenoxyphenyl)-7H-pyrrolo[2,3-d]pyrimidin-4-ylamine, (column 9, lines 7-8), 5-[4-(4-aminophenoxy)phenyl]-7-tert-butyl-7H-pyrrolo[2,3-d]pyrimidin-4-ylamine (column 9, lines 32-33), and 5-[4-(3-aminophenoxy)phenyl]-7-tert-butyl-7H-pyrrolo[2,3-d]pyrimidin-4-ylamine (column 9, lines 34-35), are src kinase inhibitors and thus within the scope of the claims. The lack of teaching in Calderwood et al. that these compounds are src kinase inhibitors or that src kinase inhibitors as a class may be used for the treatment of VEGF-mediated edema is irrelevant as src kinase inhibitory activity is an inherent activity within at least the specific compounds listed above and each of these compounds is taught by Calderwood et al. for the treatment of edema.

Appellants argue that the Burchat et al. reference does not teach that the listed compounds as specifically inhibitors of **human c-Src** as recited in the claims. Table 2 of Burchat et

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al. clearly presents data with regard to the ability of several compounds (including those of Calderwood et al. cited in the instant rejection) to inhibit src. While it is true that it is not explicitly stated by Burchat et al. **which** src kinase (i.e., human, murine, chicken, etc.) was used in the assays described in this table, as Burchat et al. clearly was using human lck (since lck 64-509 is clearly referring to the human lck amino acid numbering), as well as human kdr and tie (see paragraph 2 of the Results section of the companion paper to the Burchat et al. paper cited), they are presumably using the human src kinase also (i.e., human c-Src). Even without any explicit teaching of which src kinase was used, a skilled artisan would have believed any mention of src without a source identified was referring to human c-Src as this is considered to be the model src kinase in the art and is the one which has been most studied.

Furthermore, even if the src kinase used by Burchat et al. is from a different source, one of skill in the art would clearly consider inhibition data for one src-kinase to be representative of a compounds ability to inhibit any src kinase as all src kinases known are highly homologous. Tyrosine kinase inhibitors in general have overlapping specificities across entire families of tyrosine kinases (i.e., inhibit more than one entire family) as can be easily seen in the many references cited by both the

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examiner and appellants wherein particular compounds are tested against a variety of distinct classes of tyrosine kinases and not against different members of the same type of kinase.

Selectivity of an inhibitor within a particular type of kinase (for example between human and murine c-Src) is rare indeed, if in fact any examples of such are even known (the examiner can find no mention of any such selectivity among any of the art of record, while art showing both overlapping and selective specificity between different types, even related types such as Src and Lck, which are both Src-family kinases, are abundant in the art).

**B. Rejection of Claims 1, 2, 17 and 18 over Calderwood et al. (Patent Application 2003/0187001) as evidenced by Burchat et al. (2000).**

Appellants argue that the Calderwood et al. application teaches that certain pyrrolopyrimidine compounds are useful for treating VEGF mediated edema but only generally mentions the Src family of tyrosine kinases along with other classes of kinases and the Calderwood et al. patent does not teach that the disclosed pyrrolopyrimidine compounds are inhibitors of human c-src. The selectivity of tyrosine kinase inhibitors is highly unpredictable with large variability in selectivity and activity depending on the spatial arrangement of substituents. This is

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not persuasive because Calderwood et al. clearly teach the use of all the specific compounds described for the treatment of VEGF-mediated edema (see paragraphs 56 and 101) and Burchat et al. clearly evidence that at least the specific compounds 4-[4-(4-amino-7-isopropyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)phenoxy]benzyl Alcohol, (paragraph 0482), 2-[4-(4-amino-7-isopropyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)phenoxy]benzyl Alcohol (paragraph 0495), 4-[4-(4-amino-7-isopropyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)phenoxy]benzonitrile (paragraph 0439) and 2-[4-(4-amino-7-isopropyl-7H-pyrrolo[2,3-d]pyrimidin-5-yl)phenoxy]benzonitrile (paragraph 0447), are src kinase inhibitors and thus within the scope of the claims. The lack of teaching in Calderwood et al. that these compounds are src kinase inhibitors or that src kinase inhibitors as a class may be used for the treatment of VEGF-mediated edema is irrelevant as src kinase inhibitory activity is an inherent activity within at least the specific compounds listed above and each of these compounds is taught by Calderwood et al. for the treatment of edema.

Appellants argue that the Burchat et al. reference does not teach that the listed compounds as specifically inhibitors of **human c-Src** as recited in the claims. Table 2 of Burchat et al. clearly presents data with regard to the ability of several

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compounds (including those of Calderwood et al. cited in the instant rejection) to inhibit src. While it is true that it is not explicitly stated by Burchat et al. **which** src kinase (i.e., human, murine, chicken, etc.) was used in the assays described in this table, as Burchat et al. clearly was using human lck (since lck 64-509 is clearly referring to the human lck amino acid numbering), as well as human kdr and tie (see paragraph 2 of the Results section of the companion paper to the Burchat et al. paper cited), they are presumably using the human src kinase also (i.e., human c-Src). Even without any explicit teaching of which src kinase was used, a skilled artisan would have believed any mention of src without a source identified was referring to human c-Src as this is considered to be the model src kinase in the art and is the one which has been most studied.

Furthermore, even if the src kinase used by Burchat et al. is from a different source, one of skill in the art would clearly consider inhibition data for one src-kinase to be representative of a compounds ability to inhibit any src kinase as all src kinases known are highly homologous. Tyrosine kinase inhibitors in general have overlapping specificities across entire families of tyrosine kinases (i.e., inhibit more than one entire family) as can be easily seen in the many references cited by both the examiner and appellants wherein particular compounds are tested



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against a variety of distinct classes of tyrosine kinases and not against different members of the same type of kinase.

Selectivity of an inhibitor within a particular type of kinase (for example between human and murine c-Src) is rare indeed, if in fact any examples of such are even known (the examiner can find no mention of any such selectivity among any of the art of record, while art showing both overlapping and selective specificity between different types, even related types such as Src and Lck, which are both Src-family kinases, are abundant in the art).

**C. Rejection of Claims 1, 2, 17 and 18 over Hirst et al. (US Patent Application 2002/0156081) as evidenced by Burchat et al. (2002).**

Applicants argue that Hirst et al does not provide an enabling disclosure of the presently claimed invention. Applicants argue that treatment of edema is discussed only generally in a laundry list of conditions in paragraph 315 of Hirst et al. and that the application states only that some of the compounds can be used to treat edema. Applicants argue that of the over 950 examples of compounds presented in Hirst et al. there is not a single data point of inhibition data. Only general allusions to unspecific activity against various diverse classes of tyrosine kinases is provided. This is not persuasive

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because despite the fact that treatment of edema is only one of several conditions to be treated, Hirst et al. clearly teach the use of each of the 982 compounds of examples 1-982 for the treatment of edema (as well as the many other diseases within the laundry list) and teach how to make each of these specific compounds and thus the methods disclosed are unquestionably enabled. As such the use of each of these compounds is clearly enabled by Hirst et al. The examples include the specific compounds trans-Benzyl N-[4-[4-amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]carbamate (see paragraph 0686), trans-N-[4-[4-Amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]benzamide (see paragraph 0697), trans-N-[4-[4-Amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]-2,2-dimethyl-3-phenylpropanamide (see paragraph 2549), trans-N-[4-[4-Amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]-3-methyl-3-phenylbutanamide (see paragraph 2562), trans-N-[4-[4-Amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]benzo[b]furan-2-carboxamide, (see paragraph 2585), Trans-3-[4-(Benzylamino)-3-methoxyphenyl]-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-4-

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amine, (see paragraph 0929) and trans-N-[4-[4-Amino-1-[4-(4-methylpiperazino)cyclohexyl]-1H-pyrazolo[3,4-d]pyrimidin-3-yl]-2-methoxyphenyl]-3-phenylpropanamide (see paragraph 1696) which Burchat et al. (2002) evidence are src kinase inhibitors (see Tables 3 and 4). As such the treatment of edema with each of these specific compounds as is taught by Hirst et al. anticipates the instant claims.

Appellants argue that the Burchat et al. reference does not teach that the listed compounds as specifically inhibitors of **human c-Src** as recited in the claims. Table 2 of Burchat et al. clearly presents data with regard to the ability of several compounds (including those of Calderwood et al. cited in the instant rejection) to inhibit src. While it is true that it is not explicitly stated by Burchat et al. **which** src kinase (i.e., human, murine, chicken, etc.) was used in the assays described in this table, as Burchat et al. clearly was using human lck (see the final paragraph on page 1687 of Burchat et al.), they are presumably using the human src kinase also (i.e., human c-Src). Even without any explicit teaching of which src kinase was used, a skilled artisan would have believed any mention of src without a source identified was referring to human c-Src as this is considered to be the model src kinase in the art and is the one which has been most studied. Furthermore, even if the

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src kinase used by Burchat et al. is from a different source, one of skill in the art would clearly consider inhibition data for one src-kinase to be representative of a compounds ability to inhibit any src kinase as all src kinases known are highly homologous. Tyrosine kinase inhibitors in general have overlapping specificities across entire families of tyrosine kinases (i.e., inhibit more than one entire family) as can be easily seen in the many references cited by both the examiner and appellants wherein particular compounds are tested against a variety of distinct classes of tyrosine kinases and not against different members of the same type of kinase. Selectivity of an inhibitor within a particular type of kinase (for example between human and murine c-Src) is rare indeed, if in fact any examples of such are even known (the examiner can find no mention of any such selectivity among any of the art of record, while art showing both overlapping and selective specificity between different types, even related types such as Src and Lck, which are both Src-family kinases, are abundant in the art).

**D. Claims 3, 4, 19, 20, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calderwood et al (US Patent 6,001,839), Calderwood et al. (US Patent Application 2003/0187001) and Hirst et al. (US Patent Application 2002/0156081) in view of Hanke et al.**

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Appellants argue that the alleged structural similarity between the Calderwood compounds and PP1 and PP2 is superficial at best. The compounds of the Calderwood references are pyrrolopyrimidines, whereas PP1 and PP2 are pyrazolopyrimidines. The additional nitrogen in PP1 and PP2 relative to the Calderwood compounds could have a significant effect on activity and selectivity as inhibition of tyrosine kinases is highly unpredictable. In addition, the Calderwood compounds have a bulky phenoxy substituent on the phenyl ring, whereas PP1 and PP2 have relatively small methyl and chloro substituents on the phenyl ring. These differences could have significant effects on the selectivity as small changes in structure can lead to large changes in activity and selectivity. This is not persuasive as applicants arguments ignore the Hirst et al. reference entirely. The Hirst et al. reference teaches pyrazolopyrimidines and teaches the same utilities for these compounds as taught for the pyrrolopyrimidine compounds of the Calderwood et al. references. The similarities in structure are clear and as all the compounds are disclosed for the same utilities the skilled artisan would believe other similar structures would have these same utilities. The similarity of the compounds PP1 and PP2 of Hanke et al., to the compounds of each of the three references, and in particular to the pyrazolopyrimidines of Hirst et al. is very

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clear. As such the skilled artisan would have a reasonable expectation that these compounds could be used in similar fashion. Appellants are reminded that obviousness does not require an absolute certainty of success but merely a reasonable expectation thereof.

Appellants argue the alleged structural similarities between PP1 and PP2 to the compounds of Hirst et al. is also superficial as all of the alleged inhibitor compounds specifically disclosed in this reference have a bulky alkyl or heteroaryl ring attached to the phenyl substituent of the pyrazolopyrimidine. In contrast, PP1 and PP2 merely have a relatively small methyl or chloro substituent, respectively, on this phenyl ring and PP1 and PP2 both have a t-butyl substituent on the nitrogen at the 7-position of the pyrazolopyrimidine ring, while the compounds disclosed in Hirst et al. have various cyclic substituents at this position. However, this is not persuasive as the overall structural similarity of all the compounds of the combination of all three references is very striking. Despite the enormous number of compounds described by the combination all of them share an identical ring structure with differences in the ring structure only at the 6 position (carbon in the pyrrolopyrimidine compounds of the Calderwood reference and nitrogen in the pyrazolopyrimidine

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compounds of the Hirst et al. and Hanke et al. references), with substitution at positions 4, 5 and 7 of the ring structure. Furthermore, the substitutions at position 4 are all include an amino group, the substitutions at position 5 all include a substituted phenyl group and the substitutions at position 7 can all include small alkyl chains. Even if appellants statement that none of the compounds of Hirst et al. may have a t-butyl group at this position is correct (the examiner's reading of paragraphs 63-66 in which R<sub>2</sub> is described indicates that this substituent could be a t-butyl group), clearly the compounds of the Calderwood et al. references both include t-butyl group at this position.

Appellants also argue that the examiner's reliance on *In re Ngai*, 70 USPQ2d 1862 for the rejection of Claims 19, 20, and 32 even if one were to conclude that there is not a reasonable expectation of treating edema with PP1 and PP2 should be reversed as Ngai is readily distinguishable from the instant situation. Appellants argue that the specific composition containing human c-src tyrosine kinase inhibitor and capable of modulating vascular permeability increase as defined by these claims is not in the prior art and neither is a packaged version of that composition as claimed. The argument is not understood. Hanke et al. unquestionably teaches compositions of PP1 and PP2.

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There is no difference between the compositions of PP1 and PP2 of Hanke et al. and those of the instant claims. Furthermore, the inclusion of a pharmaceutical composition in a package with printed material is well known in the art and does not define a patentable feature of subject matter of the claims. What the printed matter states cannot define the invention. While a new use for an old product may be patentable the product itself is not. Appellants statement that the new printed matter unquestionably conveys new utility, a new feature, to the package, not previously known to one of ordinary skill in the art in fact admits that the only thing new is a **new utility**. The composition has not changed. It is well settled in patent law that merely discovering a new use or a new property of something present in the prior art does not make it patentable. Hanke et al. clearly teach compositions of PP1 and PP2 identical to those in the claimed article of manufacture of these claims. The only difference between the claimed product and that of Hanke et al. is the inclusion of the composition in a packaged form with a label. As previously stated this is a standard form in the art for providing a pharmaceutical composition and Hirst et al. teach that PP1 and PP2 have known pharmaceutical uses. As such the provision of the composition of Hanke et al. in such an article would have been obvious.




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**(11) Related Proceeding(s) Appendix**

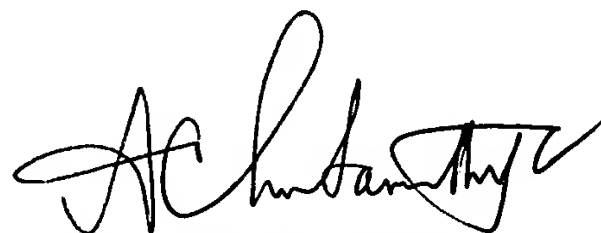
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Rebecca Prouty  
Primary Examiner  
AU 1652



PONNATHAPUACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Conferees:

Ponnathapura Achutamurthy

Bruce Campell



BRUCE R. CAMPPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600